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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,400	04/26/2001	Takanori Nishimura	450100-03182	3418
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FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			ROHWER, JACOB P	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,400

Applicant(s)

NISHIMURA, TAKANORI

Examiner

Jacob P. Rohwer

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,13-19,22-28 and 31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-10,13-19,22-28 and 31-38 is/are rejected.
- 7) ☒ Claim(s) 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

Claim 34 is objected to because of the following informalities: the claim is directly dependent upon cancelled claim 29. Appropriate correction is required. Examiner will assume claim dependency should be directed towards pending amended claim 28.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6, 10, 15, 19, 24, 28, 33, 37 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No 6,335,966 to Toyoda.

Regarding claim 1, Toyoda discloses an information processing apparatus (**Fig 1**) configured to transmit an E-mail information, said E-mail information including an E-mail message body and an attached file to a reception terminal (**Col 5 Lin 59-63**), the apparatus comprising:

an accommodating capability verifying unit configured to verify (**Fig 3 #31, 36, and 37**) an information accommodating capability in said reception terminal or in a communication system encompassing said reception terminal, based only on a domain of an E-mail address used in sending the E-mail information to said reception terminal;

(Fig 6 Col 7 Lin 3-11 and 35-40 discloses E-mail domain name record, Fig 8 discloses a hierarchy of domain name servers (DNS), and Col 13 Lin 15-20 discloses a capability inquiry that can possibly determined by the domain name of the recipient only, furthermore Col 13 Lin 35-38 discloses capability information determined based on a host name included in the domain of an address, independent of a user name “xxx”).

an information converting unit configured to convert the E-mail **(Fig 3 #20)** information into a format matching the information accommodating capability in said reception terminal or in said communication system encompassing said reception terminal, if the information accommodating capability in said reception terminal or in said communication system encompassing said reception terminal is not matched to said E-mail information; **(Col 5 Lin 58-60, Lin 45-54)** and

a transmission unit configured to transmit said E-mail information. **(Fig 3 #33)**

Regarding claim 6, Toyoda further discloses the information processing apparatus according to claim 1 wherein the attached file is an image file. **(Col 6 Lin 7-9 discloses the TIFF file attached is an image.)**

Regarding claim 10, please see rejection of claim 1. Additionally, the apparatus of claim 1 performs the method of claim 10.

Regarding claim 15, which depends from claim 10, please see rejection of claim 6 above. Additionally the apparatus of claim 6 performs the method of claim 15.

Regarding claim 19, please see rejection of claim 1. Additionally, Toyoda further discloses a reception terminal **(Fig 3, corresponds to the IFAX machine disclosed in**

Fig 1 as transmitting and receiving E-mails) including reception unit (Fig 3 #34) for receiving said E-mail information sent from said transmission terminal and information opening unit for open the transfer information. (Fig 3 #35)

Regarding claim 24, please see rejection of claims 6 and 19 above.

Regarding claim 28, please see rejection of claim 19. Additionally, the system of claim 19 performs the method of claim 28.

Regarding claim 33, which is assumed to depend from claim 28, please see rejection of claim 6 above. Additionally the apparatus of claim 6 performs the method of claim 33.

Regarding claim 37, please see rational provided in the rejection of claims 1 and 10. The apparatus of claim 1 and the method of claim 10 correspond to the medium for causing an information process apparatus to execute a program of claim 37. **(Toyoda Fig 2 #21-22, Col 5 Lin 15-18)**

Regarding claim 38, please see rational provided in the rejection of claims 19 and 28. The apparatus of claim 19 and the method of claim 28 correspond to the medium for causing an information process apparatus to execute a program of claim 38. **(Toyoda Fig 2 #21-22, Col 5 Lin 15-18)**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 7, 13-14, 16, 22-23, 25, 31-32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda as specified in claims 1, 6, 10, 15, 19, 24, 28 and 33 above, in view of US Patent No 6,775,688 to Kakimoto.

Regarding claim 4, Toyoda does not expressly disclose the apparatus of claim 1 wherein, if said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit is configured to include in the E-mail information a statement of a method enabling a user of said reception terminal to confirm the contents of said attached file.

However, Kakimoto discloses an information processing apparatus (**Fig 1**) wherein, if said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit is configured to include in the E-mail information a statement of a method enabling a user of said reception terminal to confirm the contents of said attached file. . (**Col 2 Lin 27-33, a link to a network where the specified data is stored is distributed to the desired destinations.**) By clicking on a link sent to the reception terminal, distributed data can be accessed when the information accommodating capability is not conducive to the data sent. This would be considered a method enabling a user of said reception terminal to confirm the contents of said file information.

The Toyoda and the Kakimoto Patents are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to inform the reception terminal of the use of an access link to a network as specified in the Kakimoto Patent in order to access data from a reception terminal not capable of accommodating the data at the actual destination of the reception terminal, as specified in Toyoda.

The suggestion/motivation for doing so would have been to allow the user of the reception terminal to access information even though the reception terminal E-mail cannot accommodate the data designated to be transmitted.

Therefore it would have been obvious to combine the Kakimoto Patent with the Toyoda Patent in order to obtain the invention in claim 4.

Regarding claim 5, Toyoda does not expressly disclose that if the said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit sends accessing information to means for saving said attached file in said E-mail as a method enabling the confirmation of the contents of said attached file.

However, Kakimoto discloses an information processing apparatus (**Fig 1**) that if the said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit sends accessing information to means for saving said attached file in said E-mail as a method enabling the confirmation of the contents of said attached file. **(Col 2 Lin 27-33, a link to a network where the specified data is stored is distributed to the desired destinations so that the data can be accessed.)**

The Toyoda and the Kakimoto Patents are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to inform the reception terminal of the use of an access link to a network as specified in the Kakimoto Patent in order to access data from a reception terminal not capable of accommodating the data at the actual destination of the reception terminal, as specified in Toyoda.

The suggestion/motivation for doing so would have been to allow the user of the reception terminal to access information even though the reception terminal E-mail cannot accommodate the data designated to be transmitted.

Therefore it would have been obvious to combine the Kakimoto Patent with the Toyoda Patent in order to obtain the invention in claim 5.

Regarding claim 7, Toyoda further discloses the information processing apparatus according to claim 1 wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes a format of the attached file. **(Col 5 Lin 48)**

Toyoda does not expressly disclose the information processing apparatus according to claim 1 wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes a maximum size of the E-mail information and a maximum file size of the attached file.

However, Kakimoto discloses an information processing apparatus wherein the information accommodating capability of said reception terminal or said communication

system encompassing said reception terminal includes the maximum size of the E-mail information and the maximum file size of the file information. **(Col 2 Lin 27-37)**

There is disclosed a determination means in which the size of the specified data is determined to be smaller or larger than a predetermined size capability of the destination.

The Toyoda and the Kakimoto Patents are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the predetermined size threshold of the specified E-mail data as specified in the Kakimoto Patent in order to determine the information accommodating capability of the reception terminal as specified in Toyoda.

The suggestion/motivation for doing so would have been to avoid excessive load on the network because a large size of data is transmitted and can't be accommodated. **(Kakimoto, Col 1 Lin 24-27)**

Therefore it would have been obvious to combine the Kakimoto Patent with the Toyoda Patent in order to obtain the invention in claim 7.

Regarding claim 13, which depends from claim 10, please see rejection of claim 4 above. Additionally the apparatus of claim 4 performs the method of claim 13.

Regarding claim 14, which depends from claim 13, please see rejection of claim 5 above. Additionally the apparatus of claim 5 performs the method of claim 14.

Regarding claim 16, which depends from claim 10, please see rejection of claim 7 above. Additionally the apparatus of claim 7 performs the method of claim 16.

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Regarding claims 22, 23 and 25, please see rejections of claims 19, 4, 5 and 7 above.

Regarding claims 31, 32 and 34, please see rejections of claims 28, 4, 5 and 7 above.

Claims 8, 17, 26 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Toyoda and Kakimoto as specified in claim 7 above, and further in view of US Patent No 6,421,429 to Merritt et al.

Regarding claim 8, the combination of Toyoda and Kakimoto as specified in claim 7 above discloses the information processing apparatus according to claim 6 wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes a maximum size of the E-mail, an image format of the attached image file, and a maximum file size of the attached file. Furthermore, Toyoda discloses an image processing apparatus that determines information accommodating capability of a reception terminal including a maximum pixel size of the image corresponding to said image file and color capability.

(Fig 3 #20 Resolution and Color/Monochrome Converting Section, Col 6 Lin 50-54 mentions the resolution and color capability of the image.)

The combination does not expressly disclose that the information accommodating capability includes a *maximum* number of colors of the image corresponding to the image file.

However Merritt discloses an image processing apparatus that determines information accommodating capability of a reception terminal including a maximum number of colors of the image corresponding to said image file. **(Col 10 Lin 35-39)**

The combination of Toyoda and Kakimoto and the Merritt Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the maximum number of colors of the image corresponding to the image file as specified in the Merritt Patent in order to determine the information accommodating capability of the reception terminal as specified in the combination of Toyoda and Kakimoto.

The suggestion/motivation for doing so would have been to allow for correct image processing with respect to colors in the transmission of the image data from a transmitting to a receiving terminal.

Therefore it would have been obvious to combine the Merritt Patent with the combination of Toyoda and Kakimoto in order to obtain the invention in claim 8.

Regarding claim 17, please see rejection of claims 8 and 10 above. Additionally the apparatus of claim 8 performs the method of claim 17.

Regarding claim 26, please see rejection of claim 8 and 19 above.

Regarding claim 35, please see rejection of claims 8 and 28 above. Additionally the system of claim 19 performs the method of claim 35.

Claims 9, 18, 27 and 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda as specified in claims 1, 6, 10, 15, 19, 24, 28 and 33 above, in view of US Patent Publication No 2001/0039615 to Bowker et al.

Regarding claim 9, Toyoda discloses the information processing apparatus according to claim 6.

Toyoda does not expressly disclose the information processing apparatus according to claim 6 wherein, if said image file is a moving image file and the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal corresponds only to a still image file, said information converting means renders one or plural frames making up said moving image file into the attached file attached to said E-mail information.

However, Bowker discloses a data transmission apparatus that translates video to still images when a specific data processing terminal can't accommodate the data format transmitted. **(Para [0001] and Para [0006] Lin 1-10)**

The Toyoda Patent and the Bowker Publication are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to translate video to still images as specified in the Bowker Publication in order to convert the image file to be transmitted as specified in Toyoda.

The suggestion/motivation for doing so would have been to allow for the user of the reception terminal to view the image file when the accommodating capability of the terminal does not allow them to view a video or motion image file.

Therefore it would have been obvious to combine Bowker Publication with the Toyoda Patent in order to obtain the invention in claim 9.

Regarding claim 18, please see rejection of claims 9 and 10 above. Additionally the apparatus of claim 9 performs the method of claim 18.

Regarding claim 27, please see rejection of claims 9 and 19 above.

Regarding claim 36, please see rejection of claims 19 and 28 above. Additionally the system of claim 19 performs the method of claim 36.

Response to Arguments

Applicant's arguments with respect to claims 1, 4-10, 13-19, 22-28, and 31-38 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the combination of Maeda and IwaZaki do not disclose or suggest the amended independent claims in regard to the determination of a reception terminal's accommodating capability based only on a domain of an intended E-mail address. This argument is moot based on the new grounds of the rejection provided in the Toyoda reference as set forth in the 102 and 103 rejections above.

Furthermore, applicant argues that multiple (or three) transmission occur between the receiving and transmitting terminals in order to determine accommodating capability. However it is noted that this limitation is not incorporated into the amended claims, and further this argument with respect to Maeda and IwaZaki is once again moot based on the grounds of the new rejection provided with Toyoda.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob P. Rohwer whose telephone number is 571-272-5509. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JR
5/17/06



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